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10/581,953	06/07/2006	Eiichiro Yokochi	CU-4850 BWH	7389
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EXAMINER				
DICUS, TAMRA				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/581,953

Applicant(s)

YOKOCHI ET AL.

Examiner

TAMRA L. DICUS

Art Unit

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11/15/07.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/55/08)
Paper No(s)/Mail Date 11-15-07
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

The specification objection and the 112 2nd rejections of claims 9 and 12 are withdrawn due to Applicant's amendments.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-12 stands rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, as previously set forth in the 06/14/07 Office Action.
3. Instant Claims 1-7 are not clear because they are grammatically awkward. Careful revision is necessary to put the claims in proper form to convey the scope of the invention as Applicant intends. Particularly, it is not clear if the uppermost surface of the base material layer further comprises the impregnated paper, because the surface layer comprised the same impregnated paper (i.e. "surface resin layer *comprises at least* a surface layer, blocking layer, *and* impregnated paper"... "base layer further comprises the impregnated paper". Thus, not clear how many layers are present. It appears the phrase is attempting to create Markush grouping denoting options, but relying on one of the options in one layer and comprising that option in another layer which is confusing because the surface layer and base layer are different). Which is further not clear because even if the base comprised the paper, it is already comprised in the surface layer. It is not clear if there is an additional second paper layer within the base. Further the new amendment "is adjacent to the impregnated paper layer of the surface layer" does not

further limit the claim because the surface (including the optional paper layer) and base layers are laminated in line 2 and thus are already adjacent to each other. Claims 2 and 4-7 have similar issues with the blocking layer, since it is already part of the surface layer. Thus the overall structure for Claims 1-12 is not clear. It appears if additional layers are employed, "further comprising" language should be used and refer separately to the different layer (claims 1-8).

- a. Applicant argues that the amended language is clear ("the impregnated paper layer is comprised in each of the surface layer and base layer"), however, it still is not clear because the claims are replete with grammatical errors causing separate layers to be identified as belonging to the surface layer (which appears to be improper Markush language), but then uses those same layers in the base layer and the language doesn't further limit the claim as explained above (the claim tries to refer to paper layers singularly instead of referring to a first and second or first an "another" paper layer). Applicant's arguments at page 2 specify that both the surface and base layer contain "the impregnated paper layer" which implies that a single layer of paper is in both the surface layer and the base layer at the same time. So, are the surface layer and base layer distinct or are they one in the same? Also similar issues are found in claim 1 with "the thermosetting resin" in line 6 referring to the blocking layer's thermosetting resin in line 5.
5. Alternative expressions are permitted if they present no uncertainty or ambiguity with respect to the question of scope or clarity of the claims. One acceptable form of alternative expression, which is commonly referred to as a Markush group, recites members as being "selected from the group consisting of A, B and C." See Ex parte Markush, 1925 C.D. 126 (Comm'r Pat. 1925). See MPEP 2173.05. It is still not clear if

the base layer comprises another impregnated layer. A suggestion would be to differentiate between one or two different impregnated paper layers, if that's how many are present, i.e. surface layer comprising (use proper Markush language reciting all the options), and numerically order how many impregnated paper layers are present in the surface layer (i.e. a first impregnated paper layer) and the base layer (i.e. a second impregnated paper layer).

b. Applicant argues methods; however the claims are to products.

4. Claim 3 is unclear because if there is an impregnated paper layer adjacent to a base layer, then a pattern ink layer cannot be between them. And again, the surface resin layer comprises the blocking layer, so to reference them as separate is not clear as to how many layers are present.

5. Instant Claim 4 further is not clear what is intended by “the blocking layer is on a surface resin layer side”, it is unclear if the independent blocking layer is a part of the same surface resin layer mentioned in claim 1 or an additional one. Further it is unclear to “and is not impregnated in the paper comprising the impregnated paper layer”, and similar issues as set forth in claim 1 exists here with using the impregnated paper and the blocking layer options of the surface resin layer. The overall structure is not clear. Claim 6 has similar issues.

6. Further to Claim 6, this amendment is confusing as it is not clear how – “an independent blocking layer” further limits the blocking layer. The blocking layer is a layer so it is already independent. Further the blocking layer is comprised in the surface resin layer which makes it dependent it appears. The language is ambiguous. Similar issues exist with Claim 4.

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 1-8, and 10 stand rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3 of U.S. Patent No. 6514624 to Takemoto in view of Takeuchi et al, and over claims 1-10 of US 6558799 to Takeuchi in view of Takemoto, as set forth in the 06/14/07 Office Action.

- a. Applicant has not presented any arguments to this rejection, and thus the Examiner maintains this rejection.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-8, and 10 stand rejected under 35 U.S.C. 102(b) as being anticipated by

Takemoto as previously set forth in the 6/14/07 Office Action.

a. Applicant argues Claim 1 has been made clear by the amendment in that the surface layer and the base material layer has the impregnated layers, however, this is not clear for the reasons set forth above. This rejection is maintained because if the surface layers have a pattern layer between them (as set forth in claims 3 and 5, and claim 7), Takemoto teaches this. The primer layer 5 embraces the surface resin layers and the pattern ink layer is the pattern ink layer 2, and the impregnated paper base layer 1 is the base material layer of FIG. 2. The impregnated paper layer is an optional surface layer as recited in instant claim 1. This rejection applies to the surface layer options of the surface cured resin layer and the blocking layer as set forth in claim 1 as set forth in the prior Office Action.

11. Claims 1-8, and 10 stand rejected under 35 U.S.C. 102(b) as being anticipated by

Takeuchi et al. as previously set forth in the 6/14/07 Office Action.

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a. Applicant argues the impregnated paper layers in both the surface and base are not found in Takeuchi. However, as previously explained, the claims do not necessarily recite this. Also, Takeuchi still teaches the surface layer options of the surface cured resin layer and the blocking layer as set forth in claim 1 and the base impregnated paper layer substrate as set forth in the prior Office Action.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arai et al. as previously set forth in the 6/14/07 Office Action.

13. If there is a first and second impregnated paper layer, Arai still teaches this as layers 1 and 4 of FIG. 4 are both impregnated paper layers and adjacent to each other as previously set forth. Thus layer 1 serves as the surface resin layer and layer 4 as the base layer.

a. Applicant argues Arai doesn't teach a blocking layer because of it's intended purpose (for blocking an ooze out of an uncured material), however this is not convincing because the blocking layer 6 is cured resin and is not porous and functions as applicant's blocking layer. Applicant contends Arai's method of making a decorative sheet doesn't teach a blocking layer because of the effects. However, this hasn't been proved.

b. Applicant further argues that Arai teaches irradiating a thermosetting resin with UV rays to fully cure the resin, but is completely silent regarding using an ionizing radiation curing resin. This argument is not understood because UV rays are sources of radiation and thus the resins applicant alleges are different are one in the same.

14. Claims 8-9 and 11-12 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Arai et al., over Takemoto, and Takeuchi et al. in view of Rosenkranz et al., as previously set forth in the 6/14/07 Office action.

a. Applicant does not present any arguments toward this rejection and thus the Examiner maintains the rejections for reasons previously set forth.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TAMRA L. DICUS whose telephone number is (571)272-1519. The examiner can normally be reached on Monday-Friday, 7:00-4:30 p.m., alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Tamra L. Dicus /TLD/
Examiner
Art Unit 1794

February 8, 2008

/Terrel Morris/
Terrel Morris
Supervisory Patent Examiner
Group Art Unit 1794